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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,674	05/03/2001	Wipul Jayasekara	SJO920000096US1	8478
7590	05/19/2004			EXAMINER
Ron Feece				RENNER, CRAIG A
INTERNATIONAL BUSINESS MACHINES CORPORATION				
Dept. L2PA			ART UNIT	PAPER NUMBER
5600 Cottle Road			2652	11
San Jose, CA 95193				DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/848,674	JAYASEKARA, WIPUL
<b>Examiner</b>	<b>Art Unit</b>	
Craig A. Renner	2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 February 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-52 is/are pending in the application.  
 4a) Of the above claim(s) 21-46 is/are withdrawn from consideration.  
 5) Claim(s) 1,2,11,12,47,48,51 and 52 is/are allowed.  
 6) Claim(s) 3-10,13-20,49 and 50 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 25-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4, filed 6 May 2003.
  
2. Independent claims 1 and 11 are allowable and generic with respect to at least some of the species. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 5, 8-10, 15, and 18-20 are no longer withdrawn from consideration since all of the claims to these species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 21-24 remain withdrawn from consideration pursuant to 37 CFR 1.142(b) since they do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141. Election was made **without** traverse in Paper No. 6, filed 23 June 2003.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "wherein the longitudinal bias layer comprises an electrically nonconductive HM material disposed outside of the active region and in abutting contact with the two opposite sides of the active region" as set forth in claim 10 must be shown or the feature(s) canceled from the claim(s).

Corrected drawings and/or an amendment to the claim(s) are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

### ***Specification***

4. The disclosure is objected to because of the following informalities:

- a. In lines 9-10 of claim 47, line 14 of claim 49, and line 15 of claim 51, each instance of "pinned spacer and free layers" should be changed to --pinned, spacer and free layers-- for better clarity.

b. In line 38 of claim 51, "the magnet recording disk surface" should be changed to --the magnetic recording disk surface-- in order to more clearly refer back to that set forth in line 2 of claim 51.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-10, 13-20, and 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In line 1 in each of claims 3-8 and 10, it is indefinite as to which of the "first and second longitudinal bias layers" set forth in line 19 of independent claim 1 is being referenced by "the longitudinal bias layer".

b. In line 2 of claim 9, it is indefinite as to which of the "first and second longitudinal bias layers" set forth in line 19 of independent claim 1 is being referenced by "the longitudinal bias layer".

c. In line 1 in each of claims 13-18 and 20, it is indefinite as to which of the "first and second longitudinal bias layers" set forth in line 25 of independent claim 11 is being referenced by "the longitudinal bias layer".

d. In line 2 of claim 19, it is indefinite as to which of the “first and second longitudinal bias layers” set forth in line 25 of independent claim 11 is being referenced by “the longitudinal bias layer”.

e. In lines 19-20 of claim 49, “the first and second side extensions” are indefinite because they lack clear and/or positive antecedent basis.

f. Claim 50 inherits the indefiniteness associated with independent claim 49 and stands rejected as well.

***Double Patenting***

7. Applicant is advised that should claim 19 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Allowable Subject Matter***

8. Claims 1-2, 11-12, 47-48, and 51-52 are allowable over the prior art of record. Claims 3-10, 13-20, and 49-50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

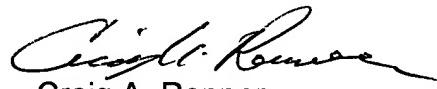
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (703) 308-0559. The examiner can normally be reached on Tuesday-Friday 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Craig A. Renner  
Primary Examiner  
Art Unit 2652

CAR